

Application No. 10/552,121  
Paper Dated: June 26, 2008  
In Reply to USPTO Correspondence of March 27, 2008  
Attorney Docket No. 1376-053035

**REMARKS**

The Office Action of March 27, 2008 has been reviewed and the Examiner's comments carefully considered. The present Amendment amends claims 1, 12 and 15. No new matter has been added. Support for these amendments can be found in the specification and drawings as originally filed. Specifically, support for these amendments can be found in the specification at page 8, lines 25 to 30 and Fig. 2. Accordingly, claims 1-21 are currently pending in this application, and claims 1, 12 and 15 are in independent form.

**35 U.S.C. §102 Rejections**

Claims 1, 2, 6, 9-12, 15 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,167,739 to Hutchinson et al. (hereinafter "the Hutchinson patent"). In view of the above amendments and the following remarks, the Applicants respectfully request reconsideration of this rejection.

As defined by amended independent claim 1, the present invention is directed to a method for forming a document set. The document set is formed from rectangular sheets of the same size and includes an envelope sheet and at least one insert sheet. The envelope sheet is printed with envelope information, including a unique code identifier to identify the envelope sheet. The insert sheet is printed with insert information, including a further unique code identifier to identify each insert sheet. The envelope sheet and at least one insert sheet is collated to form a document set.

The Hutchinson patent is directed to a method of forming a multi page mailer type business from three different sheets, a top sheet (10), a middle sheet (12) and a bottom sheet (13). The top and bottom sheets (10, 13) are manufactured simultaneously with perforations inside of perimeter areas of three of the edges. Adhesive is applied to the top and bottom sheets (10, 13). The sheets (10, 12, 13) are provided in a vertical stack into a laser printer (67), first printing the top sheet (10) from tray (66), then the middle sheet (12) from tray (68) and then the bottom sheet (13) from tray (66) and the sequence being repeated. The printer (67) also prints machine readable identification information, a bar code (69), on each of the sheets (10, 12, 13) that are to be provided in a final mailer. The same bar code (69) is printed on each of the sheets (10, 12, 13) of a particular set. The scanning/verification stage (74) utilizes any conventional reader which can read the bar coding (69) or like identification information to make sure that the proper sheets (10, 12, 13) are provided. The sheets are then collated at (75).

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The Hutchinson patent does not teach or suggest use of a single envelope sheet. Instead, the Hutchinson patent requires the use of two separate sheets in the form of a top sheet (10) and a bottom sheet (13) that are adhered together to form a container, e.g., column 6, lines 12 to 15. The Hutchinson patent does not teach or suggest using one sheet to form an envelope about the insert sheets; in contrast, in independent claims 1, 12 and 15 of the present invention, the envelope to contain the set of documents is formed from a rectangular sheet of exactly the same size and dimension as the rectangular sheets used to form the insert sheets.

In addition, the Hutchinson patent does not teach or suggest the use of unique code identifiers that uniquely identify each sheet of the document set. In the Hutchinson patent, there are common codes as the Examiner has pointed out, general to all sheets in the set of documents and all documents of a set are sharing the same machine readable identification information. These common codes are used in the Hutchinson patent to verify matching sheets in a set. Therefore, it is impossible to uniquely identify each insert sheet and envelope as required by the present invention. Each sheet in the present invention has a unique identifier printed thereon, one identifier per sheet, and also one unique identifier per envelope. In this way the system is able to perform self-referencing checks, including: number of sheets in the document set; type of content; indication of an insertion of a separate item such as a credit card; and determination of proper order. The Hutchinson patent fails to teach or suggest this type of self referencing test.

Therefore, the Hutchinson patent fails to teach or suggest an envelope formed of one sheet of the same type as the insert sheets. The Hutchinson patent also fails to teach an identifier code unique and to each sheet. For the foregoing reasons, the Applicants believe that the subject matter of amended independent claims 1, 12 and 15 is not anticipated by or rendered obvious over the Hutchinson patent. Reconsideration of the rejection of claims 1, 12 and 15 is therefore respectfully requested.

Claims 6 and 9-11 depend from and add further limitations to amended independent claim 1 and are believed to be patentable for the reasons discussed hereinabove in connection with amended independent claim 1. Claim 16 depends from and adds further limitations to amended independent claim 15 and is believed to be patentable for the reasons discussed hereinabove in connection with amended independent claim 15. Reconsideration of the rejection of claims 1, 2, 6, 9-12, 15 and 16 are respectfully requested.

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### **35 U.S.C. §103 Rejections**

Claims 3-5, 7, 8, 13, 14 and 17-21 stand rejected under 35 U.S.C. §103(a) as being obvious over the Hutchinson patent in view of Fig. 1 and Applicant's admitted prior art (AAPA). In view of the above amendments and the following remarks, the Applicants respectfully request reconsideration of this rejection.

As set forth in MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, each and every claim limitation must be considered. Where claimed limitations are simply not present in the prior art, a *prima facie* rejection is not supported. With regards to the Hutchinson patent, as stated above, important elements of the invention as recited in amended independent claims 1, 12 and 15 are simply not taught. The AAPA fails to cure the deficiencies of the Hutchinson patent. The present invention requires the use of single envelope sheets. Also, the present invention requires unique identifiers for each sheet. In addition, the present invention requires the self-referencing integrity check which, in addition to the number of sheets, also checks that the proper sheets are present for the envelope.

The AAPA only discloses the use of close-faced envelopes, not an envelope sheet as discussed in the AAPA. Using closed face envelopes causes many problems, such as the need for highly specialized equipment for insertion and also prohibits auditing and checking of the insertion sheets without actually manually removing the inserted sheet and verifying the information.

Furthermore, the AAPA in no way describes the use of a unique code identifier for each element of the document set, both the envelope sheet and the insert sheet.

Still further, the AAPA only teaches performing an integrity check with regard to the insert sheets and not to the document set as a whole, and certainly does not include the envelope. Further, the integrity check of the AAPA is not self-referencing. Instead, the AAPA describes a comparison between the identifier information on the insert sheets and a process data file. Applicants respectfully assert that the Examiner has failed to provide a *prima facie* case of obviousness as required under 35 U.S.C. §103(a).

For the foregoing reasons, the Applicants believe that the subject matter of claims 3-5, 7, 8, 13, 14 and 17-21 is not obvious over the Hutchinson patent in view of AAPA. Reconsideration of the rejection of claims 3-5, 7, 8, 13, 14 and 17-21 are therefore respectfully requested.

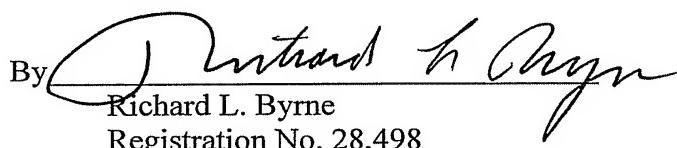
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**CONCLUSION**

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-21 are respectfully requested.

Respectfully submitted,  
THE WEBB LAW FIRM

By

  
Richard L. Byrne  
Registration No. 28,498  
Attorney for Applicants  
436 Seventh Avenue  
700 Koppers Building  
Pittsburgh, PA 15219  
Telephone: (412) 471-8815  
Facsimile: (412) 471-4094  
E-mail: webblaw@webblaw.com